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10/088,715	03/19/2002	Alex Roche	B-4537PCT 619589-5	7580

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EXAMINER	
ALLEN, WILLIAM J	
ART UNIT	PAPER NUMBER
3625	

NOTIFICATION DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No.	Applicant(s)	
	10/088,715	ROCHE, ALEX	
	Examiner	Art Unit	
	WILLIAM J. ALLEN	3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *18 December 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1 and 63-77* is/are pending in the application.

4a) Of the above claim(s) *74-77* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1 and 63-73* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Prosecution History Summary

Claims 63-77 have been added.

Claims 2-62 have been canceled.

Claims 74-77 are hereby withdrawn by the Examiner.

Response to Arguments

Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection (incorporating newly cited PTO form 892 reference V "MediaFlex"). Applicant's amendment has necessitated the new grounds of rejection.

Claim Objections

Claim 71 is objected to because of the following informalities: Claim 71 recites dependency from claim 89; however, no claim 89 exists. For Examination purposes, the claim will be treated as dependent from claim 69. Appropriate correction is required.

Election/Restrictions

Newly submitted claims 74-77 are directed to an invention that is independent or distinct from the invention originally claimed. The application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

Group I, claims 1 and 62-73, drawn to a method of operating an online retailing operation for retailing of at least one print product to a customer, said print product supplied by a print merchant.

Group II, claims 32-43, drawn to an online content retailer operation and associated method.

The inventions listed as Groups I-II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: Claims 74 and 77 recite various features such as performing a transaction of a third type with a third party content provider to allow for reproduction of at least one of the image items. Conversely, the originally elected of claim 1 describes a third transaction is performed between a print merchant and a print service provider for printing and shipping of the print product. In addition, claims 74 and 77 also recite aspects such as transacting an order of a fourth type done in response to the second and third type orders for effecting delivery.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 74-77 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

1. Claims 1, 63-64, 67-68, and 72-73 is rejected under 35 U.S.C. 103(a) as being unpatentable over Garfinkle (US 6133985) in view of von Rosen (US 6493677) in further view of PTO form 892 reference V (herein referred to as MediaFlex).

Regarding claim 1, Garfinkle teaches:

displaying a plurality of image items for online viewing by said customer at a content retailer web site operated by or for a content retailer (see at least: col. 2 line 64-col. 3 line 4, col. 3 lines 19-21 and 62-67, col. 4 lines 1-6 and 61-66, col. 5 lines 7-13, col. 7 lines 5-16 and 45-49). The Examiner notes that the scanning center and image server are accessed through interface B and constitute a "content retailer";

transacting an order of a first type between said customer and said content retailer for supply of said at least one print product based on said customer ordering said at least one print product after viewing at least one of said image items at said content retailer (see at least: col. 5 lines 7-13 and 25-34, col. 7 lines 5-16 and 45-49, Fig. 5→5A(note 5D)→5D→5E(note element 5o)); The Examiner notes that the user access the scanning center/image server through interface B to place and order, the order being stored on the server for transfer to the fulfillment center;

transacting an order of a second type between said content retailer and said print merchant for fulfillment of said first type order by said print merchant (see at least: col. 9 lines 17-21 and 25-28, Fig. 5E (note #5o)); The Examiner notes that order placed through interface B are stored on the image server and transferred to the fulfillments center (i.e. print merchant).

Additionally, despite Garfinkle teaching where the fulfillment center "fulfills, charges, and delivers" an order (see at least: col. 3 lines 21-23), and further where the order may "be delivered by standard mail" (see at least: col. 9 lines 34-35), Garfinkle does not expressly teach *transacting an order of a third type between said print merchant and a print service provider for shipping said at one print product ordered by the customer pursuant to said first type order.*

In the same field of endeavor, von Rosen teaches a system allowing users to submit digital images, edit and customize those images, and have those images branded (i.e. printed) on merchandise labels (see at least: abstract). In addition, von Rosen further teaches *transacting an order of a third type between said print merchant and a print service provider for shipping said at one print product ordered by the customer pursuant to said first type order* (see at least: Fig. 10B and 13B, col. 5 lines 55-63). It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention of Garfinkle to have included *transacting an order of a third type between said print merchant and a print service provider for shipping said at one print product ordered by the customer pursuant to said first type order* as taught by von Rosen in order to provide a system that for creating and ordering customized branded merchandise over a computer network that advantageously automates the production of the

merchandise and the shipping of the merchandise to the customer upon confirmation of the order (see at least: von Rosen, col. 2 lines 1-12, Fig. 13B).

Furthermore, though Garfinkle teaches transacting orders of a first and second type with retail customers, Garfinkle does not explicitly teach *offering a direct service to business customers for generating print products from their own content*, nor does Garfinkle teach the fulfillment of *business customer* orders by the print merchant. Garfinkle further fails to show where *image items being made available to said content retailer for public merchandising* are from *at least one third party content provider*. The Examiner additionally notes that the practice of providing both retail service to general customers as well as business services to business customers is both old and well known in the art of providing printing services.

In the field of providing print services online, MediaFlex teaches that enables e-commerce and the distribution of on-demand image-based products (see at least: Page 1). More specifically, MediaFlex teaches *offering a direct service to business customers for generating print products from their own content* and the fulfillment of *business customer* orders by the print merchant (see at least: Page 3 #1, Page 4 #s 3-5, Page 6 #s 6-8 and 11). MediaFlex further teaches *image items being made available to said content retailer for public merchandising* are from *at least one third party content provider* (see at least: Page 3 #2, Page 6 #9, Page 9 #s12-14 (note: Marvel is a third party content provider)).

Thereby, it would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention of Garfinkle to have included such features as taught by MediaFlex in order to provide customers with creative print template tools that enable them to create printed products that deliver their message with impact (see at least: Page 3 #2; Also note Page 6 #8 and Page 4 #5). The Examiner additionally notes that the incorporation of such features is no more than the predictable use of prior art elements according to their established function.

Regarding claims 63-64 and 67-68, Garfinkle in view of von Rosen teaches in view of MediaFlex teaches:

(63) *wherein said step of transacting an order of a first type comprises: receiving a specification of said print products from said customer, said specification comprising data selected from the set, media size; media type; number of copies; delivery name; delivery address; ink type* (see at least: Garfinkle, abstract, col. 7 lines 11-16, col. 9 lines 29-35, Fig. 5D-5E).

(64) *wherein said step of transacting an order of a first type comprises receiving a specification of said print products from a customer terminal, in the form of an electronically transmitted data file* (see at least: Garfinkle, col. 3 lines 1-4 and 58-61, Fig. 5E(note # 5o)).

(67) *receiving a price data from said print merchant* (see at least: Garfinkle, 5D (note 5h)).

(68) *obtaining an electronic image data describing a said image item; said electronic image data obtained via a communications network; and electronically sending said electronic image data to said print merchant* (see at least: Garfinkle, col. 3 lines 1-4 and 58-61, col. 9 lines 17-21 and 25-28, Fig. 5E (note #5o)).

Regarding claims 72-73, Garfinkle teaches all of the above as notes and further teaches the collection of shipping and billing information from the user placing a print order. Garfinkle also teaches where the billing information based on the delivery option selected and print price (see at last: Fig. 5D-5E). Garfinkle, however, lacks the aspect of *itemizing* the various prices/costs on a presented bill. Von Rosen teaches a system allowing users to submit digital images, edit and customize those images, and have those images branded (i.e. printed) on merchandise labels (see at least: abstract). Von Rosen also teaches *itemization* of the presented bill including distinctly/separately showing the shipping (i.e. delivery) cost as well as the purchase price (see at least: Fig. 10A-11B). It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention of Garfinkle to have included *itemization* of various costs including delivery price and print price as taught by von Rosen in order to provide a system that displays a summary of an order including a short description of the order and permit a user to return to any previous page to correct any incorrect items (see at least: von Rosen, col. 10 lines 59-67).

2. Claims 65-66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garfinkle in view of von Rosen in view of MediaFlex, as applied to above, and further in view of Blumberg (US 20030140315).

Regarding claim 65, Garfinkle in view of von Rosen in view of MediaFlex teaches all of the above as noted and further teaches wherein said step of transacting an order of a second type comprises the steps: sending an order to said print merchant, specifying details of said print products (see at least: col. 5 lines 7-13 and 25-34, col. 7 lines 5-16 and 45-49, Fig. 5→5A(note 5D)→5D→5E(note element 5o)). The combination, however, does not expressly teach receiving confirmation of said order from said print merchant. In the same field of endeavor, Blumberg teaches receiving confirmation of said order from said print merchant (see at least: 0003, 0062, 0112, 0114, 0116). It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention of Garfinkle in view of von Rosen in view of MediaFlex to have included receiving confirmation of said order from said print merchant as taught by Blumberg in order to provide an on-line printing service that a user can preview multiple styles without the need for the user to have to envision how his own text and graphics would appear inserted into a reference sample and without the need for the printing company to run off physical samples in multiple styles that include an easy means of order confirmation such as email (see at least: Blumberg, 0003, 0104).

Regarding claim 66, Garfinkle in view of von Rosen in view of MediaFlex in view of Blumberg teaches *wherein said step of sending an order to said print merchant comprises sending said order in the form of an electronically transmitted data file* (see at least: Garfinkle, col. 3 lines 1-4 and 58-61, Fig. 5E; Blumberg 0006, 0062, 0176, 0212, Fig. 6).

3. Claims 69 is rejected under 35 U.S.C. 103(a) as being unpatentable over Garfinkle in view of von Rosen in view of MediaFlex, as applied to above, and further in view of Arnold et al. (US 6016504, herein referred to as Arnold).

Regarding claim 69, Garfinkle in view of von Rosen in view of MediaFlex teaches all of the above as noted and teaches the relationship between scanning center, fulfillment center, and delivery service (see at least: Garfinkle, col. 2 line 64-col. 3 line 4, col. 3 lines 19-21 and 62-67, col. 4 lines 1-6 and 61-66, col. 5 lines 7-13, col. 7 lines 5-16 and 45-49, Fig. 5-5E; von Rosen col. 5 lines 55-63). Though Garfinkle in view of von Rosen in view of MediaFlex teaches these relationships between a scanning center, fulfillment center, and delivery service (i.e. a *content retailer, print merchant, and print service provider*), it does not specifically teach *a contract* between the entities and *storing the contract electronically*. Arnold teaches establishing a contract relationship between a virtual outlet (i.e. retailer) and a merchant (see at least: abstract, col. 11 lines 35-43). More particularly, a virtual outlet and merchant enter into a contract with the contract being stored electronically (col. 10 lines 32-34, col. 11 lines 35-43, col. 13 lines 51-57, Fig. 9, 11, and 20). It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention of Garfinkle in view of von Rosen in view of MediaFlex to have included *storing an electronic* contract as taught by Arnold in order to allow the merchants, retailers, etc. involved to easily access and change the terms of the contract if desired (see at least: (col. 10 lines 32-34, col. 11 lines 35-43, col. 13 lines 51-57, Fig. 9, 11, and 20).

4. Claims 70-71 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garfinkle in view of von Rosen in view of MediaFlex in view of Arnold, as applied to claim 69, and further in view of PTO 892 reference U.

Regarding claims 70-71, Garfinkle in view of von Rosen in view of MediaFlex in view of Arnold teaches all of the above as noted and teaches the relationship between scanning center (retailer), fulfillment (merchant) center, and delivery service (print service provider), and further teaches where a contractual agreement exists between the retailer and the merchant (see at least: Garfinkle, col. 2 line 64-col. 3 line 4, col. 3 lines 19-21 and 62-67, col. 4 lines 1-6 and 61-66, col. 5 lines 7-13, col. 7 lines 5-16 and 45-49, Fig. 5-5E; von Rosen col. 5 lines 55-63; Arnold, abstract, col. 11 lines 35-43). Garfinkle in view of von Rosen in view of MediaFlex in view of Arnold, however, does not expressly teach the contract defines a relationship between the retailer and the merchant in respect to at least one of *a definition of a print product, a special discount available to the content retailer, or a plurality of prices for said print products,* nor does the combination teach *calculating price data according to the stored contract.*

In the same field of endeavor, PTO 892 U teaches magazine publishers (i.e. a content retailer) dealing with service providers such as printers/print vendors (see at least Paragraph 1). The publisher is able to receive benefits such as volume discounts/price concessions from the vendor for providing business not traditionally received by the vendor. Vendors are able to give the publisher the price concessions/volume discounts knowing that they will receive business from a publisher as part of a deal (i.e. contract) for a given time period such as 3 years (see at least:

Paragraphs 23-26). Thereby, PTO 892 U teaches where a contract defines a relationship between the retailer and the merchant in respect to at least one of *a definition of a print product, a special discount available to the content retailer, or a plurality of prices for said print products* and further where *a price data is calculated according to the stored contract.* . It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention of Garfinkle in view of von Rosen to have included *a contract between a content retailer and a print merchant* as taught by 892u in order to provide a mutually beneficial agreement that provides for volume discounts/price concessions to a content retailer while assuring a print merchant receives guaranteed business that otherwise it would not receive (see at least: 892u, Paragraph 25). The Examiner notes that the price is determined based on the agreement.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- US 5477353 A discloses a photographic image processing system having laboratory unit for processing film and photographer unit for supplying printing information
- US 7039580 B1 discloses a method, system, article of manufacture, and propagated signal for electronically ordering photographic prints and gifts from photos

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to WILLIAM J. ALLEN whose telephone number is (571)272-1443. The examiner can normally be reached on 8:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff A. Smith can be reached on (571) 272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Naeem Haq/
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